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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/770,462	01/29/2001	John A. Kriho	014530/0320	8030
22428	7590	06/13/2006	EXAMINER	
FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			HUYNH, CONG LAC T	
			ART UNIT	PAPER NUMBER
			2178	

DATE MAILED: 06/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/770,462

Applicant(s)

KRIHO ET AL.

Examiner

Cong-Lac Huynh

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 59-78 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 59-78 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: RCE filed 4/18/06 to the application filed on 1/29/01.
2. Claims 1-58 are canceled.
3. Claim 78 is added.
4. Claims 59-78 are pending in the case. Claims 59, 68 and 77 are independent claims.
5. The rejections of claims 40-46, 49-54, 57-58 under 35 U.S.C. 102(a) as being anticipated by Kraft have been withdrawn in view of the cancellation of these claims.
6. The rejections of claims 47 and 55 under 35 U.S.C. 103(a) as being unpatentable over Kraft and further in view of Dunsmoir have been withdrawn in view of the cancellation of these claims.
7. The rejections of claims 48 and 56 under 35 U.S.C. 103(a) as being unpatentable over Kraft and further in view of Billiris have been withdrawn in view of the cancellation of these claims.
8. The rejections of claims 59-63, 65-72, 74-77 under 35 U.S.C. 103(a) as being unpatentable over Kraft in view of Dunsmoir have been withdrawn in view of applicants arguments.
9. The rejections of claims 64 and 73 under 35 U.S.C. 103(a) as being unpatentable over Kraft and Dunsmoir and further in view of Billiris have been withdrawn in view of applicants arguments.

Claim Rejections - 35 USC § 112

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. Claims 59-67, 78 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding independent claim 59, it seems impossible to use a copy of an application, particularly a copy of the page layout application for editing the template. In general, when applying an application, for example, Microsoft Word or Microsoft Excel to create a document or to edit a document, Microsoft Word or Microsoft Excel is used to create or edit a document, not a copy of Microsoft Word or a copy of Microsoft Excel. Please explain and show the support of this feature in the specification.

Dependent claims 60-67, and 78 are rejected due to the dependencies of their base claim.

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claims 59-60, 67-68 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 67-68, the claims while are correspondent computer program product claims of method claims 59-60, are not consistent with the method claims 59-60.

Claims 67-68, particularly claim 67, does not require that a user has to select a data item from a plurality of stored data items and populate the changeable field of the template with the selected data item thereby generating the custom document at the server. Further, in claim 68, creating a form wherein the form comprises the changeable field paired with a list of the plurality of data items linked to the changeable fields does not require to be carried out at server – since the phrase “at the server” is deleted. Therefore, to be consistent, claims 59-60 are interpreted that the selecting step and the populating step to be performed anywhere including a client, not at a server, as in claims 67-68.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

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the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

16. Claims 59-63, 65-72, 74-77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kraft et al. (US Pat No. 6,084,585, 7/4/00, filed 7/29/98, priority 12/5/97) in view of Lange et al. (US Pat No. 6,839,733, priority 10/23/98).

Regarding independent claim 59, Kraft discloses:

- designing a template for a custom document using a page layout application executing at a workstation, where designing the template comprises defining a changeable field (col 9, lines 7-18: the field within the template is *changeable* since enlarging a field or adding extra data fields to a single menu field can be *made at a user's computer*; this shows that said template is designed with the fields of the template which are defined changeable for a custom document using an application executing at a workstation)
- linking a plurality of data items to the changeable field (col 5, lines 37-43: data linked to the fields are pre-programmed for users to select; col 8, lines 43-58 and figure 6: a plurality of data linked to the field for user to select)

- sending the template and the plurality of data items to a server (col 10, lines 15-22 and figure 1: the complete form including the template and the plurality of data items is sent to computer 102, which is a server)
- selecting a data item from the plurality of data items linked to the changeable field (col 8, lines 43-58, col 9, lines 7-18)
- populating the changeable field of the template with the selected data item thereby generating the custom document (figure 2 and col 8, lines 43-58: selecting a data item to populate the changeable field of the template to generate the complete form)

Kraft does not disclose:

- editing the template using a copy of the page layout application, the copy executing at the server

Lange discloses:

- editing the template using a copy of the page layout template, the copy executing at the server (col 20, lines 50-65, col 21, lines 7-47: editing the template using the copy of the template, the copy being executed at the server)

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Lange into Kraft since Lange discloses modifying the template at the server providing the advantage to incorporate into Kraft for desirably changing the form structure in Kraft, which is a template, when said form is submitted to the server.

Regarding claim 60, which is dependent on claim 59, Kraft discloses:

- creating a form wherein the form comprises the name of the changeable field paired with a list of the plurality of data items linked to the changeable field (figure 6 and col 8, lines 43-58, col 9, lines 7-18: field name 312 paired with a list of data items in the pull-down menu 602 linked to said field)

Regarding claim 61, which is dependent on claim 60, Kraft discloses providing a preview of the custom document by populating the changeable field of the template with one of the plurality of data items linked to the changeable field (col 2, lines 22-39, col 10, lines 34-44: view the form prior submission).

Regarding claim 62, which is dependent on claim 61, Kraft discloses populating the changeable field of the template with one of the plurality of data items comprises defining a default selection to populate the changeable field (col 8, lines 43-58: the list of pre-entered data entries is the plurality of data items defined as a default selection of data to populate the changeable field).

Regarding claim 63, which is dependent on claim 61, Kraft discloses that populating the changeable field of the template with one of the plurality of data items comprises iteratively showing the preview with each data item in the list (col 2, lines 30-34).

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Regarding claim 65, which is dependent on claim 60, Kraft discloses automatically adjusting a size of the selected data item based on a size of the changeable field (col 9, lines 7-18: changing the size of a field by adding extra data fields to be associated with a single menu field, the existing data field can be enlarged shows that the size of the field is adjusted).

Regarding claim 66, which is dependent on claim 60, Kraft discloses bundling the plurality of data items with the template in a file (col 5, lines 37-43, col 8, lines 43-58).

Regarding claim 67, which is dependent on claim 66, Kraft discloses sending the file to a server, extracting the template and the plurality of data items from the file at the server, and saving the extracted template and the extracted plurality of data items in a database (figure 1, col 10, lines 1-22: sending the complete form to the server; col 10, lines 15-25, 45-55, col 3, lines 5-31, figure 1: the data items and the template in the complete form when submitted to the server will be stored in the storage 108-110, which is a server database).

Claims 68-72, 74-76 are for a computer program product of method claims 59-63, 65-67, respectively, and are rejected under the same rationale.

Claim 77 is for a system of method claim 59, and is rejected under the same rationale.

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17. Claims 64 and 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kraft and Lange as applied in claim 60 above and further in view of Billiris et al (US Pat No. 6,212,552 B1, 4/3/01, filed 1/15/98).

Regarding claim 64, which is dependent on claim 60, Kraft and Lange do not disclose creating a mailing list, wherein the mailing list comprises a plurality of records to link to the changeable field of the template, and successfully populating the changeable field of the template with a record from the mailing list thereby generating a different document for each record.

Billiris discloses creating a mailing list, wherein the mailing list comprises a plurality of identities of message recipients (col 1, lines 40-64).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Billiris and combined Billiris into Kraft and Lange for linking the mailing list to the changeable field of the template and populating the changeable field of the template with a record from the mailing list to generate a different document for each record for the following reason. The mailing list including identities of message recipients in Billiris is a list of records of recipients as the plurality of data in Kraft.

Replacing the plurality of data linking to the changeable field in Kraft with the plurality of records of recipients in the mailing list linking to the changeable field and populating such records to the changeable field would provide different types of data to be used in populating the fields in the form.

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Claim 73 is for a computer program product of method claim 64, and is rejected under the same rationale.

Response to Arguments

18. Applicant's arguments filed 4/18/06 have been fully considered but they are not persuasive.

Applicants argue that Kraft does not disclose "editing the template using a copy of a page layout application, the copy executing at the server" but instead discloses an application that allows a user to create a page by entering data into predefined fields of a template.

As mentioned in the 112 rejection above, "editing the template using a copy of a page layout application" appears to be impossible. Therefore, the claim would make sense if changed "editing the template using a copy of page layout template, the copy executing at the server" since the copy of the template would be used for editing, not the template stored at server.

Kraft only discloses editing a template at client. Lange, in combination with Kraft, discloses editing a template at server (col 20, lines 50-65, col 21, lines 7-47).

Applicants argue that Dunsmoir does not disclose editing the HTML template, designing the template, or defining the fields in the template, and thus fails to teach, suggest, or describe at least disclose "editing the template using a copy of a page layout application, the copy executing at the server."

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Examiner does not agree completely. Dunsmoir does disclose creating a modified web page using a *modifying web page template* (col 5, line 58 to col 6, line 7) but not clearly shows the editing step. However, the Examiner provides a new reference Lange for better showing the argued feature.

Conclusion

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Barnes et al. (US Pat No. 5,970,475, filed 10/10/97).

Hawkinson et al. (US Pat No. 6,658,491, filed 12/4/98).

Bedell et al. (US Pat No. 6,801,910, 6/19/01).

Underwood et al. (US Pat No. 6,697,825, filed 8/30/00).

Lavorgna, JR. et al. (US Pat App Pub No. 2002/0184043, filed 6/4/01).

Dewhurst et al. (US Pat App Pub No. 2002/0073180, priority 12/12/00).

Emmelmann (US Pat App Pub No. 2003/0074634, filed 11/24/99).

Rogers (US Pat App Pub No. 2005/0192931, priority 11/3/00).

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is 571-272-4125. The examiner can normally be reached on Mon-Fri (8:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-4125.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Cong-Lac Huynh
Primary Examiner
Art Unit 2178
06/07/06